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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|--------------|----------------------|---------------------|------------------|
| 09/708,519 | 11/09/2000 | Satoru Nippa | 2185-480P | 1737 |
| 2292 | 7590 | 10/15/2002 | EXAMINER | |
| BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747 | | | SHOSHO, CALLIE E | |
| ART UNIT | PAPER NUMBER | | | |
| 1714 | 8 | | | |
| DATE MAILED: 10/15/2002 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|--|------------------------------|--|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/708,519 | NIPPA, SATORU | |
| | Examiner Callie E. Shosho | Art Unit 1714 | |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i> Period for Reply | | | |
| A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. | | | |
| <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). | | | |
| Status | | | |
| 1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>05 August 2002</u> . | | | |
| 2a) <input checked="" type="checkbox"/> This action is FINAL. 2b) <input type="checkbox"/> This action is non-final. | | | |
| 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213. | | | |
| Disposition of Claims | | | |
| 4) <input checked="" type="checkbox"/> Claim(s) <u>1 and 2</u> is/are pending in the application. | | | |
| 4a) Of the above claim(s) <u>3-4</u> is/are withdrawn from consideration. | | | |
| 5) <input type="checkbox"/> Claim(s) _____ is/are allowed. | | | |
| 6) <input checked="" type="checkbox"/> Claim(s) <u>1 and 2</u> is/are rejected. | | | |
| 7) <input type="checkbox"/> Claim(s) _____ is/are objected to. | | | |
| 8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement. | | | |
| Application Papers | | | |
| 9) <input type="checkbox"/> The specification is objected to by the Examiner. | | | |
| 10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). | | | |
| 11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action. | | | |
| 12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner. | | | |
| Priority under 35 U.S.C. §§ 119 and 120 | | | |
| 13) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). | | | |
| a) <input type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. | | | |
| 14) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application). | | | |
| a) <input type="checkbox"/> The translation of the foreign language provisional application has been received. | | | |
| 15) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121. | | | |
| Attachment(s) | | | |
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . | |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) | |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | | 6) <input type="checkbox"/> Other: _____ . | |

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 8/5/02.

NOTE: Applicant failed to affirm the election of claims 1-2 (see paragraph 4 of the office action mailed 2/4/02). While prosecution on the merits is being continued, for completeness of record, the applicant is advised to comply with the above.

Further, while applicant's remark with respect to rejoinder of claims 3-4 with claims 1-2 is noted, however, rejoinder will only be considered when one or more of the product claims, claims 1-2, are found allowable. See MPEP 821.04.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada et al. (U.S. 4,491,553).

The rejection is adequately set forth in paragraph 10 of the office action mailed 2/4/02, Paper No. 6, and is incorporated here by reference.

Response to Arguments

4. Applicant's arguments with respect to Marti et al. (U.S. 6,207,775) have been considered but they are moot in view of the discontinuation of this reference against the present claims.

5. Applicant's arguments filed 8/5/02 have been fully considered but, with the exception of arguments relating to Marti et al., they are not persuasive.

Specifically, applicant argues that Yamada et al. requires fibrillatable polytetrafluoroethylene (PTFE) in order to produce uniform composite while the present claims do not require such polymer.

However, in light of the open language of the present claims, i.e. "comprising", it is clear that the present claims are open to the inclusion of additional ingredients including fibrillatable PTFE as disclosed by Yamada et al.

Applicant argues that although it is well known that it is difficult for particles having a nanometer size to be dispersed homogeneously in a resin since the particles tend to agglomerate, the process used in the present invention, as set forth in claim 3, allows the aluminum hydroxide to become well dispersed in the resin without using any dis-agglomerating agent.

However, it is noted that claims 1-2, which are the only claims presently under consideration in light of the restriction requirement discussed in paragraph 1 above, are drawn to resin composite not a process for producing the resin composite. Given that Yamada et al. disclose resin composite comprising resin and aluminum hydroxide wherein the dispersion of the filler in the resin is very uniform, it is the examiner's position that Yamada et al. meets the limitations of the present resin composite claims.

Applicant also noted that while Yamada et al. disclose diameter of filler, i.e. aluminum hydroxide, as 0.01-50 μm , there is no other disclosure regarding the particle except for the examples which utilize filler with diameter of 4 μm to 8 μm . However, "applicant must look to

the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others.” *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, “nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims.” *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). Thus, given that Yamada et al. disclose particle diameter which almost completely encompasses the presently claimed range, it is the examiner’s position that Yamada et al. do meet the claim limitation with respect to diameter of aluminum hydroxide.

Applicant also argues that Yamada et al.’s dispersion evaluation is conducted visually, not by means of an electron-probe X-ray microanalyzer as presently claimed. However, given that Yamada et al. disclose that the dispersion of the filler in the resin is very uniform and that the filler such as aluminum hydroxide possesses diameter as presently claimed, and further given that Y/X as presently claimed is a measure of the dispersion of the aluminum hydroxide in the resin and that the higher the dispersion degree, the smaller the index, it is the examiner’s position, absent clear and convincing evidence to the contrary, that the composite of Yamada et al. would inherently possess index Y/X as presently claimed.

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

CS.
Callie Shosho
10/10/02

Vasu Jagannathan
VASU JAGANNATHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700